APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,649	02/27/2004	Bruce Gordon	BGOR.006A	9152

			EXAMINER
20995	7590	04/07/2006	TSUI, WILSON W

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

ART UNIT	PAPER NUMBER
2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
		10/789,649	GORDON ET AL.
Office Action Summary		Examiner	Art Unit
		Wilson Tsui	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 February 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>20040227</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is filed in response to the application filed on 2/27/2004, and IDS filed

on 2/27/2004.

2.   Claims 1-15 are pending. Claims 1 and 14 are independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1, 7-10, 14 and 15 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Mehrle (US Patent: 5,794,236, issued: Aug. 11, 1998, filed: May 29,

1996) in further view of Leonardos (US Patent: 6,778,972 B2, issued: Aug. 17, 2004,

filed: Dec 4, 2000).

With regards to claim 1, Mehrle teaches a method of generating a document

management system, the method comprising:

a) *Importing one or more documents in electronic form* (Fig 5a, reference number 50,

column 8, lines 11-22: whereas, a digital document is imported for classification into an

organizational/hierarchical structure containing categories and subcategories as shown

in Fig 2.)

b) *Designating an organizational structure including main categories and one or more*

   levels of subcategories (column 5, lines 39-46: whereas, an organizational / legal

hierarchical structure is designated through commercial attainable means, or also

manually created/designated by a user).

c) *Assigning the one or more documents to one or more of the main categories and*

subcategories within the organizational structure (Fig 2., column 9, lines 45-53:

whereas, the document is assigned a classification level (each level is indicative of a

category or subcategory) in the organizational structure shown in Fig 2.).

However, although Mehrle imports, designates, and assigns one or more

documents to categories within an organization/hierarchical structure, Mehlre does not

expressly teach *automatically generating a document management system including*

the one or more documents organized within the organizational structure and accessible

via a computing system.

Leonardos however teaches *automatically generating a document management system*

including the one or more documents organized within the organizational structure and

accessible via a computing system: whereas, all documents are organized in an

indexed folder hierarchical structure (Figs 1C-1 to 1C-5, column 6, lines 23-40).

Furthermore, a web site is automatically generated for use as a document management

system for providing access to the indexed electronic documents and is stored on a

server (column 5, lines 56-60: whereas the website is accessed by using a browser),

and the web site is accessible over the internet (column 5, lines 38-45).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Mehrle's organizational system, by using Mehrle's

classification (document assignment data) with Leonardos's indexing data to have

automatically generated a document management system (which was accessible over the internet) as taught by Leonardos. The combination would have allowed Mehrle's organizational system to have allowed users navigation and access to the organizational structure, through a user interface and also allowed for maintenance of the navigational structure.

With regards to claim 7, which depends on claim 1, Mehrle and Leonardos teach a method *wherein the document management system comprises a website and is accessible via the Internet* (column 5, lines 56-60: whereas the website is accessed by using a browser) and the web site is generated to provide a document management system, and is accessible thorough the internet (column 5, lines 38-45)).

With regards to claim 8, which depends on claim 1, Mehrle and Leonardos teach a *document management system* as explained in claim 1, and is rejected under the same rationale.

Furthermore, Leonardos teaches a document management system *comprises a CD-ROM and is accessible via a computer* (column 1, lines 1-25: whereas, a document management system (or elements thereof) can be housed in a storage medium such as a CD-ROM and is accessible via a server or remote computer).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Mehrle and Leonardos invention to have also included a document management system comprising a CD-ROM, and was accessible by computer, as also taught by Leonardos. The combination would have allowed alternate

means for storing/retrieving data related/used by the document management system, and an alternate means for data mobility/transfer.

With regards to claim 9, which depends on claim 1, for a method wherein the document management system comprises computer readable storage medium, is similarly explained in claim 8, and is rejected under the same rationale.

With regards to claim 10, which depends on claim 1, Mehrle and Leonardos teach *the one or more documents*, as explained in claim 1, and is rejected under the same rationale. Furthermore, Leonardos teaches the forms *comprise forms associated with a specific industry* (Fig. 12A: whereas the industry shown is Intellectual Property.)

With regards to claim 14, Mehrle teaches a method of automatically generating computer readable electronic information, the method comprising:

a) *Associating electronic documents within an organization structure designated by a user, wherein the organizational structure includes main categories and one or more levels of subcategories*, as similarly explained in claim 1, and is rejected under the same rationale.

However, Mehrle does not teach a method for *automatically generating a website indexing the electronic documents within the organization structure, modifying one of the electronic documents using a user interface, and automatically updating the website to reflect the modified electronic document.*

Leonardos teaches a method comprising:

a) *Automatically generating a website indexing the electronic documents within the organization structure:* whereas, all documents are organized in an indexed folder

hierarchical structure (Figs 1C-1 to 1C-5, column 6, lines 23-40). Furthermore, a web site is automatically generated to provide access to the indexed electronic documents and is stored on a server (column 5, lines 56-60: whereas the website is accessed by using a browser), and the web site is accessible over the internet (column 5, lines 38-45).

b) *Modifying one of the electronic documents using a user interface* (Fig 12I-2, column 16, lines 25-30: whereas, the user is able to modify one of the electronic documents using the user interface, by selecting various options such as 'Edit' or 'Delete'.)

c) *Automatically updating the website to reflect the modified electronic document* (column 5, lines 60-65: whereas, the server automatically updates the website to reflect all activities (including modification of documents))

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Mehrle's indexing system to have further included the ability to have automatically generated a website for indexing, modifying and updating documents within an organizational structure as taught by Leonardos. The combination of Mehrle and Leonardos would have allowed Mehrle's system to have "allowed users to store their computer files in a manner that is easy to organize for later retrieval and usage" (column 2, lines 49-51).

With regards to claim 15, which depends on claim 14, Mehrle and Leonardos teaches a method for *automatic updates*, as similarly explained in claim 14, and is rejected under the same rationale. Furthermore, Leonardos also teaches a method wherein the automatic update is *transparent to the user* (column 15, lines: 20-30:

whereas, when a user modifies a file, such as deleting the file, the document

management system updates the indexing data without the user knowing it).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Mehrle and Leonardos's automatic updating system, to

further included the ability to have provided updates that were transparent to the user,

which was also taught by Leonardos. The combination of Mehrle and Leonardos would

have allowed Mehrle's system to have reduced user intervention, thus simplifying the

user interaction with Mehrle's system.

4.   Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Mehrle (US Patent: 5,794,236, issued: Aug. 11, 1998, filed: May 29, 1996) and

Leonardos (US Patent: 6,778,972 B2, issued: Aug. 17, 2004, filed: Dec 4, 2000) in

further view of Ludwig et al. (US Patent: 6,816,904 B1, issued: Nov. 9, 2004, filed: May

4, 2000).

With regards to claim 2, which depends on claim 1, Mehrle and Leonardos teach

a method for *importing*, in claim 1, and is rejected under the same rationale. However,

Mehrle and Leonardos do not teach a method wherein the step of importing *further

comprises modifying properties of the one or more documents.*

Ludwig et al teaches a step *further comprises modifying properties of the one or more

documents* (column 31, lines 25-28: whereas, it is inherent that a file has properties

such as a file name, and it is taught that a property (the property being a file name) of

the file/document can be modified).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Mehrle and Leonardos's importing method to have also allowed a user to have modified a file name of the document(s) as taught by Ludwig et al. The combination of Mehrle and Ludwig et al would have allowed Mehrle's importing method to have allowed the user to change a file name for a document to a more meaningful/useful name if needed.

With regards to claim 3, which depends on claim 2, Mehrle, Leonardos, and Ludwig et al teach a similar method, as explained in the claim rejection for claim 2, and is rejected under the same rationale.

5.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mehrle (US Patent: 5,794,236, issued: Aug. 11, 1998, filed: May 29, 1996) and Leonardos (US Patent: 6,778,972 B2, issued: Aug. 17, 2004, filed: Dec 4, 2000) and Ludwig et al. (US Patent: 6,816,904 B1, issued: Nov. 9, 2004, filed: May 4, 2000) in further view of Elfering (PCT: WO 01/40967 A2, published: June 7, 2001, international filing: November 24, 2000).

With regards to claim 4, which depends on claim 2, Mehrle, Leonardos, and Ludwig et al, teach a method for *modifying the properties for a document*, as similarly explained in claim 2, and is rejected under the same rationale. However, Mehrle, Leonardos, and Ludwig et al do not teach *one of the properties comprises a digital format of the electronic form and wherein the modification includes format standardization.*

Elfering teaches *one of the properties comprises a digital format of the electronic form and wherein the modification includes format standardization* (Abstract, "transforming diverse formats and computer systems to a selected standardized format").

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Mehrle, Leonardos, and Ludwig et al's property modification method to have further included the method to transform a format for a particular document, into a standard format as taught by Elfering. The combination of Mehrle, Leonardos, Ludwig et al, and Elfering would have allowed Mehrle's system to have been able to achieve a document management system comprising/referencing with homogeneous document formats.

6.   Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehrle (US Patent: 5,794,236, issued: Aug. 11, 1998, filed: May 29, 1996) and Leonardos (US Patent: 6,778,972 B2, issued: Aug. 17, 2004, filed: Dec 4, 2000) and Ludwig et al. (US Patent: 6,816,904 B1, issued: Nov. 9, 2004, filed: May 4, 2000) in further view of Southwest (Southwest Data, published March 2000, pages 1 and 2).

With regards to claim 5, which depends on claim 1, Mehrle and Leonardos teach *importing* a digital document as explained in claim 1, and is rejected under the same rationale. However, Mehrle and Leonardos do not teach importing *comprises importing comprises importing from a third party vendor.*

Southwest teaches a *third party vendor* that converts paper documents to digital format (pages 1 and 2: whereas, a third party vendor scans paper documents and provides the scanned documents in digital format).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Mehrle and Leonardos's method for importing a digital document, to have imported a digital document using digital documents provided by a third party vendor, such as taught by Southwest. The combination of Mehrle, Leonardos, and Southwest, would have allowed Mehrle's system to cut costs by using resources provided by third party vendors.

With regards to claim 6, which depends on claim 5, Mehrle, Leonardos, and Southwest teach *wherein the third party vendor comprises a scanning company*, as similarly explained in the claim rejection for claim 5 above, and is rejected under the same rationale.

7.   Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehrle (US Patent: 5,794,236, issued: Aug. 11, 1998, filed: May 29, 1996) and Leonardos (US Patent: 6,778,972 B2, issued: Aug. 17, 2004, filed: Dec 4, 2000) in further view of HealthCare (Prudential HealthCare, published: Aug 16, 2000, page 1).

With regards to claim 11, which depends on claim 10, Mehrle and Leonardos teach *the industry*, as explained in claim 10, and is rejected under the same rationale. However, Mehrle and Leonardos do not teach the industry *comprises the health care industry*.

HealthCare teaches an HTML form which is from the *health care industry* (page 1: whereas, a feed back form for specific health care programs is shown).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Mehrle and Leonardos's method for importing documents from a particular industry to have further used forms that were specific to the health care industry as taught by HealthCare. The combination of Mehrle, Leonardos, and HealthCare would have allowed Mehrle's organizational system to have been specialized for a specific industry.

With regards to claim 12, which depends on claim 10, Mehrle, Leonardos, and HealthCare similarly teach a method wherein *the forms are associated with one or more health care programs*, as explained in the rejection for claim 11 above, and is rejected under the same rationale.

8.   Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mehrle (US Patent: 5,794,236, issued: Aug. 11, 1998, filed: May 29, 1996) and Leonardos (US Patent: 6,778,972 B2, issued: Aug. 17, 2004) in further view of Simpson et al (US Application: US 2003/0041102 A1, published: Feb. 27, 2003, filed: Aug. 27, 2001).

With regards to claim 13, which depends on claim 1, Mehrle and Leonardos teach the method of *assigning the one or more documents*, in claim 1, and is rejected under the same rationale. However, Mehrle does not teach assigning *one of a plurality of standard document sizes to the one or more documents, wherein an actual document size may not be identically equal to any of the plurality of standard document sizes.*

Simpson et al teaches a method for assigning *one of a plurality of standard*

document sizes to the one or more documents, wherein an actual document size may

not be identically equal to any of the plurality of standard document sizes (paragraph

0094: whereas, the standard document size are the available user media types, and the

actual document size is assigned to the closest matching selected standard document

size).

It would have been obvious to one of the ordinary skill of the art at the time of the

invention to have modified Mehrle and Leonardos's method for assigning properties (ie.

Main categories, or levels of subcategories) to have further included the assignment of

a closest matching standard document size, to the actual document as taught by

Simpson et al. The combination would have allowed any one of the actual documents

used by the management system to have been compatible (size-wise) with

equipment/viewers that only support standardized document sizes.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- Chen et al. (US Patent: 6,009,442, issued: Dec. 28, 1999, filed: Oct. 8,

   1997): This reference teaches implementing standardized document

   formats.

- Hsu et al (US Patent: 6,377,956 B1, issued: Apr. 23, 2002, filed: Feb. 22,

   1999): This reference teaches document management using document

   objects.

- McClendon et al (US Patent: 6,625,619 B1, issued: Sep. 23, 2003, filed: Mar. 15, 2001): This reference teaches a hierarchical method for document management.

- Song (US Patent: 6,748,185 B2, issued: Jun. 8, 2004, filed: May 24, 2002): This reference teaches choosing the closest standardized document size with respect to a scanned image.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilson Tsui whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
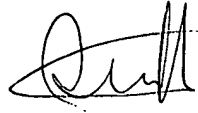
W. T 4/3/06

Wilson Tsui
Patent Examiner
Art Unit: 2178

April 3, 2006

STEPHEN HONG
SUPERVISORY PATENT EXAMINER